

Notice of Allowability

Application No.

10/616,879

Examiner

David C. Meyer

Applicant(s)

ANDO ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to March 19, 2004.
2. ☒ The allowed claim(s) is/are 1-3.
3. ☒ The drawings filed on 10 July 2003 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/803,448.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. An English translation of the foreign priority papers (Japanese Priority Application 2000-071128) was received by the Office on March 19, 2004. In the previous Office Action claims 1 and 2 were rejected as being anticipated by Massie (US 6,590,208). Claim 3 was allowed. Being that claims 1 and 2 are supported by the foreign priority document, the priority date of March 14, 2000 applies, and the rejection of claims 1 and 2 based on Massie is overcome.
2. Claims 1-3 are allowed. The following is an examiner's statement of reasons for allowance: Massie (US 6,590,208) discloses a probe holder for a scanning probe microscope apparatus having a probe, a cantilever, a displacement detection system, and a scanning unit comprising actuators for moving a probe relative to a sample along three distinct axes. One of the actuators is a "balanced momentum probe holder" assembly comprising top and bottom actuators. The top and bottom actuators are attached at a central support. A counterweight is attached to the top actuator so that its mass balances that of the bottom actuator, which carries a cantilever substrate, cantilever, and stylus (probe). Hence, this actuator assembly is held at a position in the vicinity of its center of gravity. The examiner is prevented from applying Massie to reject the instant invention because its filing date of January 19, 2001 is later than the filing date of one of the applicant's priority documents.

Apart from Massie, the prior art of record includes other scanning microscopes having positioning devices for positioning a sample relative to a probe. For example, Nakano (US 5,656,769) discloses a scanning probe microscope comprising a

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cantilever, a probe, an optical displacement detection system, and a scanning unit comprising three piezoelectric actuators for moving the probe relative to a sample along three distinct axes. However, Nakano neither discloses nor suggests holding a first actuator at a position in the vicinity of a center in dimension or a center of gravity thereof. Rather, Nakano discloses first and second actuators, which are held at their respective ends. A third, smaller actuator is attached along its length to an end of one of the first actuators, with a small portion extending beyond the attached portion. The prior art fails to disclose or suggest the invention as claimed, wherein in addition to the other claimed features, a first actuator is held at a position in the vicinity of a center in dimension or a center of gravity thereof.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

The drawings filed on July 10, 2003 are accepted by the examiner.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Meyer whose telephone number is 571-272-2442. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on 571-272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCM
June 14, 2004



DAVID PORTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800